

art. To correct this assumption, the Applicant is stating for the record that the product catalog is not prior art and requests all rejections based on the same to be withdrawn.

In the Official Action, the Examiner also rejected claim 1 as being obvious in view of the combination of David and Wells. For the reasons set forth below, the Applicant submits that the Examiner has failed to establish the prima facie case of obviousness against claim 1, and respectfully requests the Examiner to reconsider this rejection.

As set forth in M.P.E.P. §2143, to establish a prima facie case of obviousness, the Examiner must meet three basic criteria:

1. There must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.
2. There must be a reasonable expectation of success.
3. The prior art reference (or references when combined) must teach or suggest all the claim limitations.

In the present application, the Applicant submits that the Examiner has failed to establish at least the first prong of the prima facie case of obviousness. Specifically, the Examiner has failed to cite any evidence in the record that provides a motivation or suggestion for combining David and Wells.

The Examiner relies on the combination of David and Wells as rendering the subject matter of claim 1 obvious. Specifically, the Examiner cites David as disclosing the basic concept of a hacksaw with a frame constructed in an I-beam configuration with upper and lower end caps. The frame in David, however, has a sharp bend towards the front end thereof. As a result, when the blade is tensioned so as to apply a rearwardly directed load to the front end of the frame, the bending moment created in the frame member is focused at that sharp bend. The Examiner cites Wells as disclosing a hacksaw with an arcuate frame member. However, the frame member is tubular and does not have an I-beam configuration.

In the outstanding Official Action, the Examiner asserted that “it would have been obvious to one having ordinary skill in the art to provide the frame member of David with the claimed arcuate portion for providing an efficient design along with the other well known benefits described above as well as those taught by Wells.”

Under the three-pronged obviousness test set forth above, the first prong requires the Examiner to establish that there is some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine reference teachings. Specifically, the Examiner must establish that there is a suggestion or motivation to combine David and Wells together. It is submitted that this record lacks evidence of such a suggestion or motivation.

A close review of Wells reveals that it teaches away from the claimed invention, and thus there would be no suggestion to combine the I-beam of David with the arcuate frame of Wells. Specifically, in column 1, line 30 – column 2, line 40, Wells states:

It is the essence of this improvement that this reach should be both curved and tubular, and preferably it should be constructed of wrought-iron piping. It contains a maximum of strength for the purpose in hand with a minimum of weight, and at the same time the curved characteristic and the tubular characteristic combined give the reach just that degree of elasticity which, along with the requisite strength, is admirably adapted for the straining of the saw for actual work.  
(underlining added)

From this text, it is clear that Wells characterizes the tubular shape of the reach (i.e., its frame member) as being part of the “essence” of its improvement. It is the combination of both the “curved characteristic” and the “tubular characteristic” that strain the saw for work. Based on this understanding, it cannot be said that there is a motivation to substitute the I-beam from of David for the tubular frame member of Wells. Specifically, because Wells characterizes the tubular shape of the frame member or reach as being essential, or the “essence” of the improvement, one would not be motivated to change to tubular shape of the

Wells frame member. Stated differently, substituting the I-beam frame member of David for the tubular frame member of Wells would negate the teachings of Wells, namely the teaching that a tubular frame member is essential. Accordingly, it is submitted that the Examiner has failed to establish the required third prong of the obviousness test. Because the Examiner has failed to establish at least the first prong for the prima facie case of obviousness as set forth above and dictated by Federal Circuit law, it is respectfully requested that the Examiner withdraw the outstanding obviousness rejection against claim 1.

The Examiner also rejected claim 1 under the doctrine of obviousness type double-patenting over commonly owned U.S. Design Patent No. 403,224 in view of Hepworth. The inquiry for establishing a double-patenting type obviousness rejection is whether the claims of the application recite an obvious variation of the claims set forth in the issued patent. Because the claims of the present application are not limited to the ornamental appearance of a hacksaw, and instead are directed to the structure of the hacksaw frame member without regard to the specifics of its ornamental appearance, it is submitted that the claims of the present application are not obvious variations of the claim of the '224 Design patent. Accordingly, withdrawal of the double-patenting rejection is respectfully requested.

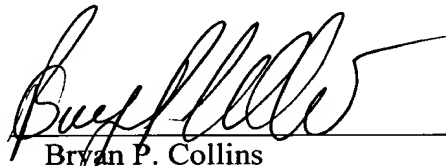
In view of the foregoing, the claims are now believed to be in form for allowance, and such action is hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, he is kindly requested to contact the undersigned at the telephone number listed below.

All objections and rejections having been addressed, it is respectfully submitted that the present application is in a condition for allowance and a Notice to that effect is earnestly solicited.

Respectfully submitted,

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